

Appl. No. 09/735,572  
Amdt. Dated December 19, 2006  
Reply to Office Action of September 20, 2006

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REMARKS

This Amendment is in response to the Office Action mailed September 20, 2006. In the Office Action, claims 1-4, 8-9 and 27-30 were rejected under 35 U.S.C. §102. Claims 2, 4, 6-7 and 14-22 were rejected under 35 U.S.C. §102. Applicants respectfully traverse the rejections in their entirety. Reconsideration in light of the remarks made herein is respectfully requested.

*Rejections Under 35 U.S.C. §102(e)*

Claims 1-4, 8-9 and 27-30 were rejected under 35 U.S.C. §102(e) as being anticipated by Yamada (U.S. Patent No. 6,407,745). Applicants respectfully traverse the rejection because a *prima facie* case of anticipation has not been established.

As the Examiner is aware, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

For instance, with respect to independent claim 1, Applicants respectfully submit that Yamada does not teach the operation of "suggesting a color based on the generated histogram to serve as the color for a template design used to display the source image, *the template design including one of a foreground and background portion displayed with the source image.*" Emphasis added.

It is alleged that Yamada teaches suggesting a color for subsequent user selection based on the generated histogram (S23) to serve as the color for the template design." *See page 3 of the Office Action.* Applicants respectfully disagree with this contention because the histogram of RGB values taught by Yamada is used to select "N" highly used, representative colors of the image, not the template design as claimed. *See page 3, lines 47-66 of Yamada.*

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With respect to claim 27, Applicants respectfully submit that Yamada does not describe "suggesting a color for subsequent user selection based on the generated histogram to serve as the color for a template design that is separate from the source image and operating as one of a foreground and background portion." Instead, as stated above, Yamada teaches color selection *for the image* based on a generated histogram and not a color selection for another illustrative element, namely the template design as claimed. *Emphasis added.*

Therefore, Applicants respectfully submit that Yamada does not disclose each and every limitation set forth in independent claims 1 and 27 as well as dependent claims 2-4, 8-9 and 28-30. Applicants respectfully reserve the right to further submit additional grounds for traversing the rejection is an appeal is warranted.

### ***Rejections Under 35 U.S.C. §103***

#### **I. CLAIMS 2 AND 4**

Claims 2 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada in view of Sako (U.S. Patent No. 5,689,575). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, the combined teachings of the cited references fail to describe or suggest all the claim limitations.

With respect to these claims, Applicants respectfully submit that (i) neither Yamada nor Sako, alone or in combination, describes or suggests an operation and/or software for suggesting a color based on the generated histogram to serve as the color for a template design used to

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display the source image, where the template design including one of a foreground and background portion displayed along with the source image.

In addition, based on the dependency of claims 2 and 4 on independent claim 1, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to separately argue the merits of allowability for these claims if an Appeal is necessary. Withdrawal of the §103(a) rejection as applied to claims 2 and 4 is respectfully requested.

## II. CLAIM 7

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada in view of Sparks (U.S. Patent No. 6,167,382). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

First, as discussed above, neither Yamada nor Sparks, alone or in combination, describes or suggests the limitation of “suggesting a color based on the generated histogram to serve as the color for a template design used to display the source image, the template design including one of a foreground and background portion displayed with the source image” as set forth in claim 1. Both Yamada and Sparks do not provide such teachings. The use of histogram for color selection of the image itself is described in Yamada. Sparks merely discloses successive computer screens presented to a client designing a merchandizing kit (Sparks, col. 21, lines 63-65). The kits comprise of menu templates, page slots and slot inserts (Sparks, col. 22, lines 8-25), indicating that the user selects among predetermined templates as opposed to suggested colors based on the generated histogram.

Moreover, in Figures 44-49, Sparks merely illustrates (1) a menu template consisting of slots, (2) a client is prompted for a price to be inserted into the slots, (3) a confirmation of the price selected, and (4) an order information page (Sparks, col. 22, lines 8-25), indicating that the template slots are merely price inserts, rather than the “color template design” comprising of color suggestions, based on the generated histogram, for presentation templates. Thus, Sparks

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does not disclose "receiving compensation for providing the color template design", as recited in claim 7.

Moreover, based on the allowability of claim 7 on its merit and its dependency on independent claim 1, believed by Applicants to be in condition for allowance, no further discussion as to the grounds of traverse are warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Hence, withdrawal of the §103(a) rejection as applied to claim 7 is respectfully requested.

### III. CLAIMS 14, 16, 18, 21-22

Claims 14, 16, 18 and 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada and in view of Tushie (U.S. Patent No. 6,202,155). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established, given that none of the cited references, alone or in combination, teach or suggest all of the claimed limitations.

For instance, with respect to the rejection of claim 14, it is noted that the Office Action states that Yamada teaches "suggesting a color based on the generated histogram to serve as the color for the template design used to display a source image." *See page 6 of the Office Action.* Applicants respectfully disagree and contend that neither Yamada nor Tushie, alone or in combination, describe or suggest the limitations of a color template design module that suggests "a color based on the generated histogram to serve as the color for a template design that is used to display the source image and is separate from the source image" as described above. Yamada does not teach the use of a histogram for formulating a suggested color for portions of the template design, where these portions are selected from a group consisting of framing, mat, background, and foreground portions of the template design. Likewise, Tushie does not provide any teachings directed to the usage of histograms to formulate color selection for the template design as claimed.

Hence, withdrawal of the §103(a) rejection as applied to independent claim 14 is respectfully requested. Moreover, based on the dependency of claims 16, 18 and 21-22 on

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independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds of traverse are warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Withdrawal of the §103(a) rejection as applied to independent claim 14 and those claims dependent thereon is respectfully requested.

#### IV. CLAIMS 15 AND 17

Claims 15 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada and in view of Tushie and Sako (U.S. Patent No. 5,689,575). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established, given that none of the cited references, alone or in combination, teach or suggest all of the claimed limitations. Applicants incorporate by reference the arguments set forth above, because none of the cited references, namely Yamada, Tushie or Sako, describe or suggest a color template design module that suggests a color based on the generated histogram *to serve as the color for a template design that is used to display the source image and is separate from the source image.* *Emphasis added.* Hence, withdrawal of the §103(a) rejection as applied to claims 15 and 17 is respectfully requested.

#### V. CLAIMS 6, 19 AND 20

Claims 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada and in view of Jammes (U.S. Published Application No. 2003/0167213). In addition, claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada and Tushie in view of Jammes and claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada in view of Tushie and Sparks. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established, given that none of the cited references, alone or in combination, teach or suggest all of the claimed limitations.

First, Applicants incorporate the arguments set forth above: None of the cited references disclose (1) a suggest color based on the generated histogram to serve as the color for a template design used to display the source image (the template design including one of a foreground and

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background portion displayed with the source image), as recited in claim 1; and (2) a color template design module...to suggest a color based on the generated histogram to serve as the color for a template design that is used to display the source image and is separate from the source image, the suggested color being applied to portions of the template design selected from a group consisting of framing, mat, background, and foreground portions of the template design.

Second, based on the dependency of claims 6, 19 and 20 on independent claims 1 and 14, believed by Applicants to be in condition for allowance as noted above, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Hence, withdrawal of the §103(a) rejection as applied to claims 6, 19 and 20 is respectfully requested.

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**Conclusion**

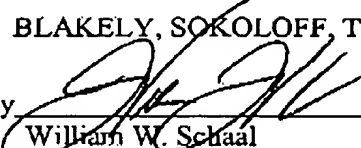
Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SORLOFF, TAYLOR & ZAFMAN LLP

Dated: December 19, 2006

By

  
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